

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested. Entry of this Amendment under Rule 116 is merited as it raises no new issues and requires no further search.

Claims 1, 4-10, 12-37 are pending in the application. Claims 13, 15, 16 and 32 have been amended to delete "substantially", overcoming the Examiner's *35 U.S.C. 112, second paragraph* rejection. Claims 8 and 27-28 have been cancelled without prejudice or disclaimer. The other claims remain unchanged.

The *35 U.S.C. 112, first paragraph* rejection of claims 1-7, 9, 12 and 21-26 is traversed because the claim limitation that the packaging sheet consists of a single material layer does not constitute new matter as alleged by the Examiner.

The Examiner's attention is respectfully directed to *Figs. 1-4* of the instant application where the protective packaging sheet according to a particular embodiment of the invention is illustrated. *Figs. 1-4* clearly disclose that the protective packaging sheet in this embodiment consists of a single material layer as presently claimed in claim 1. Thus, the claim feature is part of the original disclosure of the invention and does not constitute new matter.

The Examiner's observation in page 2, lines 2-4 from bottom of the Final Office Action is noted. Applicants respectfully disagree with the Examiner's reading of page 3, lines 16-18 of the specification to unduly limit the scope of the disclosure of the present invention to the *specific embodiment* disclosed in this passage. (Note the wording "Preferably"). The disclosure of the invention must be considered as a whole. When a person of ordinary skill in the art considers the whole disclosure of the invention, she would at once recognize that the scope of the invention is not limited to the specific embodiment disclosed in page 3, lines 16-18 of the specification, but also includes other embodiments such as the one shown in *Figs. 1-4* where the protective packaging sheet consists of a single material layer as presently claimed.

For the foregoing reasons, withdrawal of the 35 U.S.C. 112, *first paragraph* rejection is believed appropriate and therefore courteously solicited.

The first two paragraphs on page 3 of the Final Office Action appear to be rejections under 35 U.S.C. 112, *second paragraph*. Applicants will proceed accordingly.

The 35 U.S.C. 112, *second paragraph* rejection of claims 13, 15, 16 is believed overcome in view of the above amendments.

The 35 U.S.C. 112, *second paragraph* rejection of claims 19-20, 23, 25, 26, 29, 32, and 37 is traversed because the scope of these claims is definite and clear to a person of ordinary skill in the art. The Examiner states that the term "sufficient" is not defined by the claims and the specification, and a person of ordinary skill in the art would not be reasonably apprised of the scope of the claimed invention. Contrary to the Examiner's statement, the scope of the rejected claims is clearly defined *in the claims* themselves. For example, as to claim 19, a person of ordinary skill in the art would be able to readily determine the scope of this claim to cover the protective packaging sheet defined in claim 10, wherein the sheet has a compression strength of a readily determinable level that allows the sheet to sustain a specific pressure of about 57 lbf/in² without being flattened. Claim 19 is therefore definite within the meaning of 35 U.S.C. 112, *second paragraph*. The other rejected claims are also definite for similar reasons.

The repeated 35 U.S.C. 102(b) rejection of claims 1-7 and 11-12 as being anticipated by *Barnholtz* is traversed as the reference fails to teach or disclose the claimed protective packaging sheet **consisting of a single material layer**, as presently claimed in independent claim 1. Withdrawal of this anticipatory rejection is believed appropriate and therefore courteously solicited.

The repeated 35 U.S.C. 102(b) rejection of claims 1-4, 7, 9 and 12 as being anticipated by *Rudy* is traversed as the reference fails to teach or disclose the claimed protective packaging sheet **consisting of a single material layer**, as presently claimed in independent claim 1.

As to claim 9, Applicants respectfully disagree with the Examiner statement that Figs. 2, 3, 5 of *Rudy* show a distance between uppermost and lowermost levels of the sheet being less than or

equal to about 5 times a thickness of the material layer, as presently claimed. Figs. 2, 3 and 5 of *Rudy* clearly demonstrate the opposite, i.e., the distance between uppermost and lowermost levels of the sheet is *larger than 5 times* a thickness of the material layer. Reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

The 35 U.S.C. 102(b) rejection of claim 21 as being anticipated by *Rudy* is traversed at least for the reason advanced with respect to claim 1 from which claim 21 depends.

The repeated 35 U.S.C. 103(a) rejection of claim 8 as being unpatentable over *Barnholtz* is moot as claim 8 has been cancelled.

The repeated 35 U.S.C. 103(a) rejection of claim 10 as being unpatentable over *Barnholtz* in view of *McGuire* is traversed for the reason advanced in page 9, the second paragraph of the last Amendment. The Examiner's motivations stated in page 11, lines 9-11 of the Final Office Action are not found in the cited passages of *McGuire*. Applicants respectfully submit that a person of ordinary skill in the art would not have been motivated to modify the *Barnholtz* tissue paper product to include foam filled in the gaps between adjacent protuberances as taught by *McGuire* because this would change many important properties of the tissue, e.g., softness, absorbent capability, and complicate the manufacturing process of the tissue without positive results.

The 35 U.S.C. 103(a) rejection of claims 13-21 as being unpatentable over *McGuire* is traversed because the *McGuire* reference fails to disclose, teach or suggest all limitations of the rejected claims, i.e., the feature of "**repeating pattern**" recited in independent claims 10 and 1 from which claims 13-21 depend. One advantage of the claimed feature is disclosed in page 9, lines 14-17 of the specification, i.e., the overlying protective packaging sheets can *nest* or interlock to minimize the height of the stack. *McGuire* teaches away from having such a feature and does not provide the advantage of the inventive protective packaging sheet because the patent is related to a *nesting resistant* sheet material which has an *amorphous pattern* of two dimensional geometrical shapes. The computer generated pattern of *McGuire* is totally random and is not readable on the

claimed repeating pattern. *See* column 3, lines 1-14, especially lines 7-10, and column 10, lines 37-39 of *McGuire*.

Claims 13-21 are also patentable on their own merits since these claims recite other features of the invention neither disclosed, taught nor suggested by the applied art.

For example, as to claim 13, *McGuire* fails to disclose, teach or suggest the claimed **planar surface** defined by the shaped protuberances together with the foam filled in the gaps. Contrary to the Examiner's allegation, column 1, lines 25-37, column 16, lines 45-64 and column 17, lines 53-57 of *McGuire* do not teach or suggest the claimed planar surface. *McGuire* clearly requires that the filling substance be prevented from making contact with external surfaces and thus the *McGuire* product does not have a planar surface as presently claimed. *See* column 16, lines 30-31, 38-40 and Fig. 9 of *McGuire*. The *Hamilton* patent which is incorporated by reference in and hence becomes part of the disclosure of *McGuire* is cited by Applicants to emphasize the above requirement of *McGuire* which effectively teaches away from the structure of claim 13.

As to claims 14-15, *McGuire* fails to disclose, teach or suggest the claimed **overfill** feature as the substance of *McGuire* should be prevented from making contact with external surfaces.

As to claim 16, *McGuire* fails to disclose, teach or suggest the claimed printed indicia *on the planar face* defined by the shaped protuberances together with the foam filled in the gaps. Assuming *arguendo* that the *McGuire* article can be printed with indicia, the reference still fails to teach or suggest where the indicia are to be printed. It is unlikely that a person of ordinary skill in the art would have been motivated to provide indicia on the uneven surfaces of *McGuire*. *See* Fig. 9 of *McGuire*.

As to claim 17, see discussion of claim 13.

As to claims 19-20, the Examiner is kindly reminded that "a particular parameter must first be recognized as a **result-effective variable**, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) discussed in

MPEP section 2144.05. II. B. In this particular case, *McGuire* does not recognize the compression strength as a result-effective variable. Therefore, it would not have been obvious to discover the claimed compression strength through routine experimentation. In addition, since a prima facie case of obviousness has not been *properly* established by the Examiner, Applicants are not required to come forward with, e.g., a showing of unexpected results.

The 35 U.S.C. 103(a) rejection of claims 22-28 as being unpatentable over *Barnholtz* is noted.

The rejection of claims 22-26 is traversed for the reason advanced with respect to claim 1 from which claims 22-26 depend.

As to claims 22-23, see the discussion of claims 19-20 above. Applicants further submit that a person of ordinary skill in the art would not have been motivated to provide the *Barnholtz tissue paper* with the claimed compression strength as the reference being modified, i.e., *Barnholtz*, would not benefit from such a modification. In addition, there is no reasonable expectation of success because it is highly unlikely a tissue structure can have the claimed compression strength.

As to claims 25-26, see the discussion of claims 19-20 above.

The rejection of claims 27-28 is moot as claims 27-28 have been cancelled.

The 35 U.S.C. 103(a) rejection of claims 29-37 as being unpatentable over *Rudy* is traversed as the reference fails to disclose, teach or suggest the feature of independent claim 29 that the thermoplastic layer has a sufficient strength to maintain the repeating pattern when no external force is acting on said layer. The Examiner's argument in page 11, line 4 from bottom is noted. Applicants respectfully disagree with the Examiner's reading of *Rudy* as the trapped air is external force with respect to each layer in the multilayer structure of *Rudy*. Each layer of *Rudy* cannot maintain by itself the repeating pattern without the trapped air.

As to claim 32, *Rudy* fails to disclose, teach or suggest the claimed bottom contacting surface being planar.

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As to claims 35-36, see discussion of claims 19-20. Moreover, there is no reasonable expectation of success because it is highly unlikely the structure of *Rudy* having the strength primarily defined by the trapped air can have the claimed compression strength

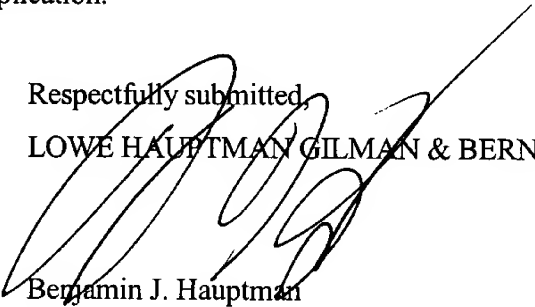
As to claim 37, see discussion of claims 19-20. Moreover, there is no reasonable expectation of success because after the structure of *Rudy* having the strength primarily defined by the trapped air has been completely flattened it will not regain a significant percentage of the initial thickness as the trapped air has escaped.

Accordingly, all claims in the present application are believed in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

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